

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE NORTHERN DISTRICT OF CALIFORNIA
3

4 SUNEARTH, INC.; and THE SOLARAY No. C 11-4991 CW
5 CORPORATION,

6 Plaintiffs,

AMENDED PERMANENT
INJUNCTION

7 v.

8 SUN EARTH SOLAR POWER CO., LTD.;
NBSOLAR USA, INC.; and DOES 1-10,

9 Defendants.

10 /

11 The Court hereby vacates its Modified Preliminary Injunction
12 issued on March 13, 2012 and issues a permanent injunction, as
13 follows:

14 IT IS HEREBY ORDERED, ADJUDGED AND DECREED that Defendants
15 and their officers, agents, servants, affiliates, employees, and
16 attorneys, and all those acting in concert or participation with
17 any of them who receive actual notice of this Order, are HEREBY
18 PERMANENTLY ENJOINED:

19 1. From using or continuing to use the words "SUN EARTH" (with
20 or without a space or capitalization or hyphen or any other
21 punctuation), either alone or in conjunction with any other words
22 or symbols, or any phonetically or visually similar words or
23 symbols in any combination (hereinafter, the term "SUN EARTH" will
24 be used to refer to the words "SUN EARTH" together with these
25 modifiers), as a trademark, service mark or trade name or
26 otherwise as a source of origin or identification of Defendants'
27 goods or services within the United States, its territories or
28 possessions (the "Territory"), provided that:

1 A. For goods branded as NBSolar rather than Sun Earth,
2 Defendants shall be permitted to identify SESP as the
3 manufacturer, importer or seller of the goods to the minimum
4 extent necessary as required by law or ordinary business customs
5 to operate within the United States under the NBSolar name; and

6 B. For equipment purchased by Defendants from sellers
7 within the United States for export to SESP in China, Defendants
8 shall be permitted to identify SESP as the buyer of the equipment,
9 to the minimum extent necessary as required by law or ordinary
10 business customs.

11 C. Under subsections A and B above, wherever possible,
12 Defendants shall identify themselves as NBSolar and/or an acronym,
13 such as SESP, that avoids the use of the term "SUN EARTH." Where
14 Defendants do use the term "SUN EARTH" under the terms of these
15 subsections, Defendants shall not display the term "SUN EARTH" in
16 a distinctive manner of presentation that makes it stand out in
17 any way from other words on the relevant document and shall not
18 use the "Sun Earth" logo.

19 2. From using or continuing to use the term "SUN EARTH" in, or
20 in connection with, any marketing or advertising or any other
21 promotional materials viewable within the Territory.

22 3. From using or continuing to use the term "SUN EARTH" as an
23 keyword or other triggering mechanism to generate any internet
24 advertising viewable within the Territory.

25 4. From using the term "SUN EARTH" as a keyword metatag on the
26 nbsolar.com domain.

1 5. From importing into the Territory any goods upon which the
2 term "SUN EARTH" appears or is shown on the packaging for such
3 goods.

4 6. From importing into the Territory any goods upon which the
5 term "SUN EARTH" appears or is shown on the product literature for
6 such goods, subject to the exceptions in Section 1(A)-(C) above.

7 7. Within fourteen (14) days of this order, Defendants shall
8 transfer the domain name sunearth.us to Plaintiffs.

9 8. Nothing in this Order shall preclude Defendants from
10 registering a domain name with any country code top level domain
11 [such as .cn (for China) or .de (for Germany)], except for the .us
12 country code top level domain, which contains the term "SUN
13 EARTH," or from publishing one or more websites at any of those
14 country code top level domains, provided that any such webpage is
15 in full compliance with the terms of this Injunction for any users
16 who view the webpage from within the Territory.

17 9. Defendants shall take reasonable measures to ensure that
18 visitors from within the United States who visit Sun-Earth.com,
19 SunEarthPower.com, SunEarthPower.net or any other website that
20 Defendants maintain with the term "SUN EARTH" in the address are
21 presented with a webpage that: (1) allows them to choose to
22 continue to either the nbsolar.com home webpage or the
23 sunearthinc.com home webpage; and (2) contains language clarifying
24 that the companies associated with those webpages are not
25 affiliated with one another;

26 10. For a period of one year from the effective date of this
27 Order, Defendants shall display on the nbsolar.com home webpage
28 the following explanation or a similar variation thereof: "NBSolar

1 USA, Inc., is a distributor within the United States of products
2 carrying the NBSolar brand, manufactured by Sun Earth Solar Power
3 Co., Ltd., of Ningbo, China. Outside of the United States, Sun
4 Earth Solar Power Co., Ltd. sells products under the brand Sun-
5 Earth. All sales in the United States, however, use only the
6 NBSolar brand."

7 11. Nothing in this Order shall preclude Defendants from
8 explaining within the Territory, including at trade shows and
9 conferences, their affiliation with their Sun-Earth name and mark
10 as used outside of the United States in the following manners:

- 11 A. By explaining orally their affiliation with the Sun
12 Earth name and mark that they use outside of the United States; or
- 13 B. For a period of ninety (90) days from the effective date
14 of this Order, by displaying at trade shows and conferences where
15 the NBSolar logo is displayed, one stand-alone sign on their trade
16 show booth, the sign being no larger than 12 inches x 12 inches in
17 black and white font not larger than 20 point typeface, the
18 following explanation, or a similar variation thereof: "NBSolar
19 USA, Inc., is a distributor within the United States of products
20 carrying the NBSolar brand, manufactured by Sun Earth Solar Power
21 Co., Ltd., of Ningbo, China. Outside of the United States, Sun
22 Earth Solar Power Co., Ltd. sells products under the brand Sun-
23 Earth. All sales in the United States, however, use only the
24 NBSolar brand." Defendants shall not depict the words "Sun Earth"
25 in a distinctive or prominent manner of presentation that makes
26 the words stand out in any way from other words or symbols in that
27 sentence or on that sign. Defendants shall not display their Sun-
28 Earth logo on that sign.

1 12. Defendants shall file with the Court and serve on Plaintiffs,
2 within thirty-five (35) days after the effective date of this
3 Permanent Injunction, a report in writing and under oath, setting
4 forth in detail the manner and form in which Defendants have
5 complied.

6 13. Defendants shall not authorize, direct or purport to
7 authorize anyone else to take actions that would constitute a
8 violation of the terms of this Injunction had Defendants taken
9 those actions themselves.

10 IT IS SO ORDERED.

11 Dated: 11/22/2013


CLAUDIA WILKEN
United States District Judge